REMARKS

Claims 1 - 29 have been canceled without prejudice or disclaimer. Claims 30 - 58 have been added in place therefor.

Claims 30 - 58 have been added in order to more particularly point out, and distinctly claim the subject matter to which the applicants regard as their invention. It is believed that this Amendment is fully responsive to the Office Action dated February 8, 2007.

With respect to the Examiner's outstanding objections to the language of claims 1 and 11 as set forth in item 4, page 2 of the outstanding Action, the applicants have canceled these claims; and in place therefor, the applicants have added claims 30 and 40, which avoid the Examiner's outstanding claim language objections. Accordingly, the withdrawal of the outstanding objections to certain claim language is in order, and is therefore respectfully solicited.

Claims 1, 3, 5, 7, 9, 11, 16, 19, 22 and 24 - 20 are rejected under U.S.C. §112, second paragraph, for the reasons set forth in items 6, pages 2 and 3 of the outstanding Action. The applicants respectfully request reconsideration of this rejection.

As indicated above, claims 1, 3, 5, 7, 9, 11, 16, 19, 22 and 24 - 20 have been canceled. Thus, the outstanding indefiniteness rejection is now moot. It is respectfully submitted that the added claims avoid the Examiner's outstanding indefiniteness rejection; and thus, the withdrawal of the outstanding rejection under 35 U.S.C. §112, second paragraph, is in order, and is therefore respectfully solicited.

Claim 25 is rejected under 35 U.S.C. §101 for the reasons set forth in item 7, pages 4 and 5 of the outstanding Action. The applicants respectfully request reconsideration of this rejection.

Claims 25 has been canceled; thus, the rejection of this claim is now moot. In place of claim 25, claim 54 has been added. It is submitted that claim 25 is patentable subject matter.

In July 1998, the Court of Appeals for the Federal Circuit, in the case of *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998), suggested that almost any unobvious software-related invention is patentable if the claims are properly drawn. The patent involved in the *State Street Bank* case, U.S. Patent No. 5,193,056, is generally directed to a data processing system for implementing an investment structure dealing with the administration and accounting of mutual stock funds.

The court held that the transformation of data in a software-related patent (*e.g.*, in the *State Street Bank* case, which represented "discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price") constitutes:

(a) a "practical application of a mathematical algorithm, formula, or calculation," but

(b) nevertheless, produces "a useful, concrete and tangible result."

In the instant case, it is clear that the above requirement item (a) is met. As to the above requirement item (2), the claimed program, as now set forth in claim 54, makes a computer execute the a claimed information processing method, which is clearly a useful, concrete and tangible result. The subject matter claimed in claim 54 is thus patentable subject matter, pursuant to the *State Street Bank* case.

Accordingly, the withdrawal of the outstanding rejection under 35 U.S.C. §101 is in order, and is therefore respectfully solicited.

As to the merits of this case, the following rejections are set forth in the outstanding Action:

(1) claims 1, 3, 5, 7, 16, 19, 22 and 24 - 27 are rejected under 35 U.S.C. §102(b) based on Inoue (U.S. Patent Application Publication 2001/0017821); and

(2) claims 9, 11 and 28 are rejected under 35 U.S.C. §103(a) based on Inoue in view of Liu (U.S. Patent No. 6,618,329).

The applicants respectfully request reconsideration of these rejections.

The applicants submit that in Inoue, although scratch operation is conducted by rotating the job dial 83 in accordance with the rotary speed thereof, it is not shown that the job dial can also be used for operation for starting/stopping reproduction-processing and moving the reproducing position to a predetermined position (due point). More particularly, in Inoue, only the "rotary speed" of the jog dial 83 is detected where pressing and touching operations that substitute the operative function of the other buttons cannot be found.

In view of the above, not all of the claimed elements or features of the applicants' claimed invention, as now recited in the claims added herewith, are found in exactly the same situation and united in the same way to perform the identical function in Inoue's system. Thus, there can be no anticipation under 35 U.S.C. §102(b) based on Inoue.

In view of the above, the withdrawal of the anticipation rejection under 35 U.S.C. §102(b) based on Inoue (U.S. Patent Application Publication 2001/0017821) is in order, and is therefore respectfully solicited.

As to the obviousness rejection, the secondary reference of Liu also discloses a rotary control element 6, which is touched by a user to set a special control mode that allows scratching operation or the like in accordance with the rotary speed and direction of the control element 6 detected by a

sensor. However, Liu also does not disclose substitution of the operative function of the other buttons as in the applicants' instant claimed invention, as now set forth in the claimed added herein.

Thus, even if *arguendo* the teachings of Inoue and Liu can be combined in the manner suggested by the Examiner, such combined teachings would still fall far short in fully the applicants' claimed invention. Thus, a person of ordinary skill in the art would not have found the applicants' claimed invention obvious under 35 U.S.C. §103(a) based on Inoue and Liu, singly or in combination.

In view of the above, the withdrawal of the outstanding obviousness rejection under 35 U.S.C. §103(a) based on Inoue (U.S. Patent Application Publication 2001/0017821) in view of Liu (U.S. Patent No. 6,618,329) is in order, and is therefore respectfully solicited.

In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper to Deposit Account No. 01-2340.

Respectfully submitted,

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